

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

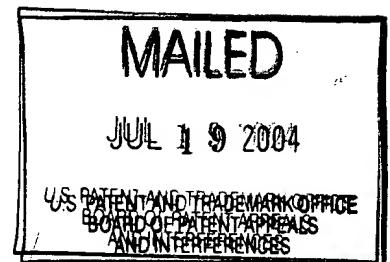
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN M. DENEROFF and STEVEN C. MILLER

Appeal No. 2003-0978
Application 09/315,806

ON BRIEF



Before JERRY SMITH, FLEMING, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-20.

Invention

Appellants' invention relates to a system and method for providing plural processing devices access to a computer system bus. Appellants' specification, page 6, lines 2-5. A processing device sends an access request to a bus controller to request bus

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access. The bus controller includes arbitration logic to select among the plural processing devices when more than one processing device requests access at the same time. The bus controller grants access to a selected one of the processing devices by sending a control signal to the selected processing device. The control signal enables a switch to provide access to the bus. Specification, page 6, lines 5-13.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of providing access to a bus, comprising:
 - receiving a request for access to the bus;
 - selecting the request according to a priority associated with the request;
 - generating a control signal in response to selection of the request;
 - enabling a switch associated with the request to provide access to the bus in response to the control signal.

References

The references relied on by the Examiner are as follows:

Trantanella	3,470,542	Sep. 30, 1969
Amini et al. (Amini)	5,396,602	Mar. 7, 1995

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Rejections At Issue

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Amini and Trantanella.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-20 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal all of the claims stand or fall together. See page 3 of the brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c) (7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of

¹Appellants filed an appeal brief on October 7, 2002. Appellants filed a reply brief on January 2, 2003. The Examiner mailed out an Examiner's Answer on November 1, 2002.

Appellants' filing of the brief. We will, thereby, consider Appellants' claims as standing or falling together, and we will treat claim 1 as a representative claim of the group.

I. Whether the Rejection of Claims 1-20 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-20. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming

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forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue, "none of the cited patents are related to any common subject matter." Appellants' brief, page 4, lines 23-24. Thus, "[t]he Examiner has merely provided conclusory ... statements using improper hindsight reconstruction without any support from any of the cited patents." Brief, page 4, lines 29-31. We find that no hindsight was needed to construct the invention of claim 1 from the combination of the Amini and Trantanella patents.

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We remind Appellants that the Examiner may find a motivation to combine prior art references in the nature of the problem to be solved. **Ruiz v. A.B. Chance Co.**, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004); **Also Pro-Mold & Tool Co. v. Great Lake Plastic Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630; **In re Huang**, 100 F.3d 135, 139 n.5; 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996).

Amini teaches that their system provides bus arbitration (control of access) in a modular digital system, i.e., a computer. See Amini at column 3, lines 35-36. Trantanella's title and column 1, lines 15-17 and 25-26, teach "modular system", "common bus", and "modular interconnection of digital systems." That is, Trantanella is directed to solving the problem of bus access in a modular digital system. Both of these patents are directed to solving the same problem addressed by Appellants, that is, controlling bus access in a modular digital system, i.e., a computer. We find that the nature of the problem to be solved provides more than sufficient motivation to combine the prior art references.

Further Appellants argue, "the proposed modification changes the principle of operation of the prior art being modified." Brief, page 5, lines 10-11. We do not find this to be the case. The Examiner's position is that given Amini does not expressly teach the details of the hardware being used to grant bus access one must look to the prior art to see such details. The Trantanella patent is used for the very limited purpose of showing that it is known in bus access control to use switches to connect the requesting device to the bus. Paper number 4, final rejection, page 2, line 22, to page 3, line 3. Nothing in the Examiner's rejection requires a change in the principle of operation of the prior art being modified.

Appellants additionally argue, "a reasonable expectation of success has not been shown by the Examiner." Brief, page 5, lines 30-31. "The proposed combination attempts to combine incompatible processing techniques that have not been shown to be capable of operating according to any degree of predictability." Brief, page 6, lines 7-10. We do not find this argument persuasive. We find that an understanding of the operation of

"data signal switching transistors" is required in order to be one of ordinary skill in this art. We find that the degree of predictability for the limited use (discussed above) of Trantanella's switching is 100 percent.

Appellants argue, neither reference discloses "an ability to limit access to a bus." Brief, page 6, lines 26-27. Further, Trantanella shows "the in-out buffers [switches] are always connected to the bus lines." Brief, page 7, line 2. "[T]he Amini, et al. patent merely controls enabling or disabling device communication capabilities. The device itself still maintains continuous access to a bus whether or not it is allowed to communicate thereon." Reply brief, page 6, lines 6-9. From Appellants' argument, it is clear to us that they are using a different definition of "access" than the definition used by the Examiner.

To determine whether claim 1 is obvious, we must first determine the scope of the claim. Our reviewing court states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they

mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellant's specification, we fail to find any definition of the term "access" that is different from the ordinary meaning. We find the ordinary meaning of the term "access" is best found in the dictionary. We note that the definition most suitable for "access" is "the right to enter or make use of".²

We appreciate Appellants' position that they are using "access" in a way that requires removal (electrical isolation) of the device from the bus (Appellants' specification, page 7, lines 24-29). However we find that the claim language does not preclude reading on merely allowing (granting the right) or not allowing the device to communicate with the bus (make use of).

² The American Heritage Dictionary, Second College Edition, 1982, page 71. Copy provided to Appellant.

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As Appellants' noted in their Reply Brief at page 6, lines 6-9, this is exactly what Amini does. For this reason, we do not find Appellants' argument persuasive.

Appellants separately note their disagreement which the Examiner's rejection of dependent claims 3, 6, 9, 12, 16, and 20, at page 7 of the Brief and page 7 of the Reply Brief. However, Appellants have failed to provide arguments as required by 37 CFR § 1.192(c)(8)(iv):

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

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Therefore, for the reasons above, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103.

Other Issues

We note that at page 7, lines 7-15, the Appellants make a request that the Examiner provide a reference to support their Official Notice contention that a 66 MHZ PCI bus is very common in the art (the mentioned 100 MHZ bus was not claimed). This request is not well founded. Appellants have already admitted that use of a 66 MHZ bus is conventional in the art. See Appellants specification at page 7, line 34, to page 8, line 8.

We also note that the Amini patent incorporates by reference a number of PCI specifications. See Amini at column 3, lines 3-12. Although these specifications were not required to reach the current decision, we strongly recommend that they be placed in the record should there be any subsequent prosecution of the present application or of a continuation thereof.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1-20.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Jerry Smith

JERRY SMITH
Administrative Patent Judge

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Notice of References Cited		Application/Control No.	Applicant(s)/Patent Under Reexamination	
		09/315,806	Examiner	Art Unit
		Paul R. Myers	2100	Page 1 of 2

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-			
B	US-			
C	US-			
D	US-			
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F	US-			
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NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)	
U	The American Heritage Dictionary, Second College Edition, 1982, page 71.	
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